

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Zellner, et al.) Confirmation No: 4937
) Group Art Unit: 3622
Serial No.: 09/740,375)
) Examiner: Duran, Arthur D.
Filed: December 19, 2000)
) Atty. Docket No.: 190252-1920
For: Identity Blocking Service from a Web Advertiser)

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed June 19, 2007 has been carefully considered.

In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 20-0778.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to arguments contained in Applicant's Appeal Brief. Although the Examiner's Answer has added some additional remarks in response to Applicant's arguments, the substance of the rejections and the Examiner's positions have not changed. Accordingly, Applicant stands behind the arguments set forth in the Appeal Brief. In addition, Applicant addresses selected responses in the following.

With regard to the Examiner's responses, the "Examiner notes that a 35 USC 103 rejection was made utilizing *Hendrey* and that it is stated above that *Hendrey* renders obvious the features of Applicant's claims." Page 7. Applicant submits that *Hendrey* does not disclose sending a location-specific advertisement to a user when the location of the user is stable and not continuously changing. Rather, *Hendrey* discloses a system for generating advertisements based on a location being visited by a user and then tracking the effectiveness of advertisements that are sent to users by monitoring the travels of a user with respect to subject of the advertisement that was sent. See, e.g., paras. 0017, 0032, 0047, and 0055.

The Examiner asserts that a conclusion of obviousness towards the claimed subject matter may be made in light of the teachings of the *Hendrey* reference and common knowledge and common sense of a person of ordinary skill in the art. This is based on select portions of the *Hendrey* reference that allegedly support the Examiner's findings. Applicant submits that nowhere does *Hendrey* disclose that an indication is made as to whether a user's location is stable or continuously changing. Also, *Hendrey* does not use such an indication to determine whether to send an advertisement to the user. To be more precise, *Hendrey* describes monitoring a

location of a user to determine effectiveness of an advertisement that was sent to the user. Further, *Hendrey* describes sending an advertisement to a user based on a current location of the user.

The Examiner asserts that one of ordinary skill in the art based on the teachings of *Hendrey* would find claimed subject matter to be obvious and further asserts that the use of hindsight reasoning is proper as long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time that the claimed invention was made. Page 12. Applicant respectfully submits that this reasoning fails to consider whether the use of hindsight reasoning establishes a *prima facie* case of obviousness or not. In the case of *Hendrey* and the use of common knowledge or common sense, Applicant submits that it would not be obvious to produce the claimed subject matter from the teachings of *Hendrey* even if all the bits and pieces of the proposed combination were known. Furthermore, Applicant submits that the Examiner has failed to articulate a reasoning that establishes a *prima facie* case of obviousness.

The Supreme Court in the recent Supreme Court decision, *KSR Int'l Co. v. Teleflex, Inc.*, informs that an Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field *to combine the elements in the way the claimed new invention does.*" See *KSR* at page 15. Here, the Examiner's stated reason to modify *Hendrey* to include the features of Applicant's claims is not actually a reason to perform such a modification to combine the elements thereof in the way the claimed invention does, because *Hendrey* already achieves the advantage that the Examiner states is a reason to further modify *Hendrey*. Namely, *Hendrey* targets users and sends advertisements based

on a user's current location and their proximity to nearby stores. See page 12. *Hendrey* therefore has no motivation to modify its teachings to send a location-specific advertisement to a user when the location of the user is stable and not continuously changing, as described in independent claim 21.

For the reasons presented herein and the reasons earlier presented in the Appeal Brief, the cited references are deficient in disclosing claimed features, and the arguments set forth in the Appeal Brief still stand. The rejection of the pending independent claim 21 and its dependent claims 22-30 should be withdrawn.

As an additional point with respect to the dependent claims 22-25 and 27-30, the Examiner cites the *Goldhaber* reference for disclosing various features, such as "targeting users with content based on geographic areas (col2, lines 27-35; col 15, lines 15-21) and that user geographic area information is known (col 13, lines 5-11)," "profiling a user, targeting content or advertising to a user based on known user information, maintaining user privacy, that user's can release user identifying information if the user so chooses (Abstract, second half; col 6, lines 22-45; col 7, lines 61-67; col 14, lines 10-17)," "obtaining second information about the identity of the user for a fee (col 6, line 64-col 7, line 5; col 17, lines 20-26; col 14, lines 7-10)," and "discloses the user indicating preferences for content to be received (Fig. 7; Fig. 10)." Accordingly, the *Goldhaber* reference describes targeting advertisements to a user based upon a user's interests and prior Internet usage. As such, *Goldhaber* does not describe criteria preselected by a user determining when advertisements are to be sent, where the criteria may include the user's current location, as described in claims 23-25, as an example. Therefore, *Goldhaber* does not remedy

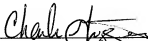
all of the deficiencies of the *Hendrey* reference and a *prima facie* case of obviousness has not been established with respect to claims 22-25 and 27-30.

Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied cited art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

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